

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

43384-32838

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Signature

Joseph M. RolnickiTyped or printed
nameJoseph M. Rolnicki

Application Number

10/815,295

Filed

April 1, 2004

First Named Inventor

Johnson

Art Unit

2877

Examiner

Punnoose, Roy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.Registration number 32,653☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Joseph M. Rolnicki
SignatureJoseph M. Rolnicki

Typed or printed name

(314) 552-6286

Telephone number

October 11, 2007
DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
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Joseph M. Rolnicki

Joseph M. Rolnicki

Reg. No. 32,653

In re application of: Johnson et al.

Serial No.: 10/815,295

Examiner: Punnoose, Roy M.

Filed: April 1, 2004

Group Art Unit: 2877

For: FIBER OPTIC FLUID PROBE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are presented in response to the Final Rejection mailed on August 9, 2007.

Claim Rejections – 35 U.S.C. § 102

Claims 1-8, 21, and 25-27 were rejected as being anticipated by the disclosure of the U.S. Patent of Harner, No. 6,118,520. Of these claims, claims 1 and 25 are independent claims. Claims 1 and 25 recite structural features of the invention that are not disclosed or suggested by the Harner reference, and therefore these claims recite allowable subject matter.

It is a fundamental tenet of patent law that an anticipation rejection requires identity of invention.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

In re Bond, 910 F.2d 831, 15 U.S.P.Q. 2d 1566, 1567 (Fed. Cir. 1990).

'[A]ny degree of physical difference, however slight, invalidates claims of anticipation.'

Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F. Supp. 1101, 39 U.S.P.Q. 2d 1969, 1980 (D. Utah 1996), *aff'd in part, rev'd in part on other grounds*, 127 F.3d 1065, 44 U.S.P.Q. 2d 1336 (Fed. Cir. 1997).

Both of the independent claims 1 and 25 that have been rejected for being anticipated by the Harner reference recite "the tubular body having an interior surface with internal screw threading on the tubular body interior surface." In the rejection of independent claims 1 and 25, the claimed internal screw threading on the tubular body interior surface is not identified in the Harner reference.

In contrast, the Harner reference discloses a tubular body 50 having a smooth cylindrical interior surface except for a peripherally continuous groove 56 in an end portion 54 of the tube adjacent an end opening of the tube, and a peripherally continuous lip 58 adjacent the groove 56 (see column 3, lines 13-19 of the Harner reference). The Harner reference does not identically show a tubular body having an interior surface with internal screw threading as required for anticipation by the above-cited case law. Because of this physical difference between the Harner tube body 50 and the tubular body of claims 1 and 25, under the above-cited case law, the anticipation rejection of claims 1 and 25 is invalid. In view of the above, there are clear factual and legal errors made in the rejection of claims 1 and 25.

Claims 1 and 25 also recite "a compression tube inside the tubular body between the tubular body internal screw threading and the optical sensing element, the compression tube having an exterior surface in sliding engagement with the interior surface of the tubular body." The rejection of claims 1 and 25 fails to identify the claimed compression tube in the Harner reference. This feature of the invention is also not identically shown by the Harner reference. This again is a clear factual error and a clear legal error in the rejections.

Independent claims 1 and 25 also recite "a compression ring inside the tubular body, the compression ring being screw threaded into the internal screw threading of the tubular body and engaging against the compression tube." The rejection of claims 1 and 25 fails to identify a disclosure of the claimed compression ring in the Harner reference. This again is a clear factual error and a clear legal error in the final rejection of claims 1 and 25.

The Harner reference discloses a tubular insert 66 that slides through the interior of the tubular probe body 50. The insert 66 is pushed through the probe body 50 by a coil spring 72. There is no disclosure or suggestion in the Harner reference of internal screw threading on the interior surface of the probe body, or of a compression tube in sliding engagement with the interior surface of the tubular body between an optical sensing element and the body internal screw threading, or of a compression ring screw threaded into the body internal screw threading and engaging against the compression tube. All of these features of the invention are recited in independent claims 1 and 25, and are not identified in the Harner reference in the rejection of claims 1 and 25. The Harner reference does not identically show all of the features of the invention recited in independent claims 1 and 25 as explained above. These physical differences invalidate the claim of anticipation of claims 1 and 25 by the Harner reference. The rejection of claims 1 and 25 as being anticipated by the Harner reference is therefore made in clear error and should be withdrawn and the claims allowed.

Claims 2-8 and 21 all depend from claim 1, and claims 26 and 27 depend from claim 25 and are therefore allowable and their rejections should be withdrawn for the same reasons discussed above.

Claim Rejections – 35 U.S.C. § 103

Claims 9-12, 18-20, 22, 28-30, and 34-36 were rejected as being obvious in view of the disclosures of the Harner reference and of the U.S. Patent of Schar et al., No. 4,826,313. Of these rejected claims, claims 9-12 all depend from independent claim 1 and claims 28-30 and 34-36 all depend from independent claim 25.

The Schar reference does not overcome the shortcomings of the Harner reference set forth above in addressing the rejection of claims 1 and 25. The Schar reference also fails to identically show a tubular body having an interior surface with internal screw threading, a compression tube inside the tubular body between the tubular body internal screw threading and an optical sensing element at one end of the tubular body, and a compression ring inside the tubular body that is screw threaded into the internal screw threading of the tubular body and engages against the compression tube. Both the Harner and Schar references fail to disclose or suggest these features of the invention.

'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the Examiner fails to establish a prima facie case, the rejection is improper and will be overturned.

In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993).

In the obviousness rejections, there is no identification in either of the prior art references of teachings that suggest the subject matter of independent claims 1 from which claims 9-12 depend, or independent claim 25 from which claims 28-30 depend. Because the prior art does not suggest the subject matter of these claims as required by the above-cited case law, a prima facie case of obviousness has not been established. The rejections of the claims are therefore based on clear factual and legal errors, and should be withdrawn.

Of claims 18-20 and 22, independent claim 18 includes all of the subject matter of original claim 1 with the additional explanation of the smooth, continuous surface between the tubular body and the tip guard. Independent claim 18 recites the tubular tip guard being secured to the tubular body distal end with an exterior seam between the tubular tip guard and the tubular body. The seam has been welded and later polished providing a continuous, smooth, cylindrical exterior surface between the tubular tip guard and the tubular body.

As explained above, neither the Harner nor Schar references suggest the subject matter of the invention recited in independent claim 1. The same subject matter has been added to independent claim 18. Because the prior art references do not suggest the subject matter of claim 18 as required by the above-cited case law, a prima facie case of obviousness has not been established. The rejections of claims 18 and claims 19, 20, and 22 that all depend from claim 18 are therefore based on clear factual and legal errors, and the rejection should be withdrawn.

Furthermore, the Schar reference discloses an outer casing 6 of a sensor 1. The drawings of the reference appear to indicate that the casing 6 is screw threaded on the distal end of a tubular body. There is no disclosure or suggestion of a welded seam between the casing 6 and the tubular body that has been later polished to provide a smooth, continuous surface between the casing and the tubular body, as recited in amended claim 18. Again, neither the Harner nor Schar references provide any suggestion of the subject matter of claim 18 as required by the above-cited case law for establishing prima facie obviousness. Again, the rejection of the claim is based on clear factual error and legal error, and the rejection should be withdrawn.

Claims 19, 20, and 22 all depend from independent claim 18, and therefore their rejections are also based on factual and legal errors and should be withdrawn.

Of the remaining claims 34-36, independent claim 34 includes "a plurality of fiber optic cables extending through the interior of the tubular body, each fiber optic cable having a proximal end adjacent the tubular body proximal end." This feature of the invention has not been identified in either of the applied prior art references in the final rejection of claim 34. In view of this, under the above-cited case law, the rejection of claim 34 fails to establish a prima facie case of obviousness. The rejection of the claim is based on clear factual and legal error, and should be withdrawn.

Furthermore, claim 34 also recites "the distal end of the tubular body being a tubular tip guard secured to the tubular body by a weld that has been later polished, the tubular body and the tip guard thereby having a smooth, cylindrical exterior surface." The Schar reference is relied on for a suggestion of this subject matter. However, the Schar reference discloses an outer casing 6 of a sensor 1. The drawings of the reference appear to indicate that the casing 6 is screw threaded on the distal end of the tubular body. There is no suggestion of a welded seam between the casing 6 and the tubular body that has been later polished to provide a smooth, continuous surface between the casing and the body, as recited in claim 34. Because this feature of the invention is not suggested in any of the prior art references relied on in rejecting claim 34, the rejection fails to establish a prima facie case of obviousness. The rejection is therefore made in clear factual error and legal error, and should be withdrawn.

Claims 35 and 36 depend from independent claim 34 and the rejections of these claims should be withdrawn for the reasons set forth above with regard to claim 34.

Claims 13-17, 23, 24, and 31-33 were also rejected as being unpatentable in view of the Harner and Schar references, and further in view of what is well-known in the art. In the rejection, official notice is taken that the limitations of the rejected claims are of a mechanical nature that is well-known in the art.

MPEP § 2144.03 sets forth the procedure for relying on common knowledge or taking official notice. This section provides guidance in determining when it is appropriate to take official notice of facts without supporting documentary evidence or to rely on common knowledge in the art in making

a rejection. There it is stated that official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. This is not the case in this application.

The elements of the invention recited in the rejected claims are not well-known and are not a part of the common knowledge in the art. To emphasize the importance of these features of the invention, of the rejected claims, claims 13, 15, 23, 31, and 32 were previously amended into independent form. As stated in MPEP § 2144.03, it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known.

The cylindrical cavity 50 recessed into the end surface 48 of the optic sensing element 36, and the optical insert 56 having a distal end portion 58 that is dimensioned to fit in the crystal cavity 50 are recited in claims 13 and 31 and are not well-known in the art.

The cleaning cap on the tubular body distal end that extends axially past and encloses the optical sensing element and has at least one side opening into an interior bore containing the optical sensing element is recited in claim 23 and is not well-known in the art.

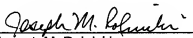
The transparent optic window mounted in the tubular body interior in a position between the optic assembly and the optical sensing element is recited in claim 32 and is not well-known in the art.

For the reasons discussed above, the rejection of claims 13-17, 23, 24, and 31-33 are based on clear factual and legal errors and should be withdrawn.

It is respectfully submitted that in view of the remarks presented herein, the application is in condition for allowance and a favorable action is requested.

Respectfully submitted,

Thompson Coburn LLP

By: 
Joseph M. Rolnicki
Reg. No. 32,653
One US Bank Plaza
St. Louis, MO 63101-1693
(314) 552-6286
Fax: (314) 552-7286